

**REMARKS**

In accordance with the foregoing, claims 5 and 34 have been amended.

Claims 1-7 and 9-46 are pending and under consideration. No new matter is presented in this Amendment.

**ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:**

Applicant requests entry of this Rule 116 Response because: the amendments of claims 5 and 34 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**REJECTIONS UNDER 35 U.S.C. §101:**

On pages 2-4 of the Office Action, the Examiner again rejects claims 5, 6, and 34-42 under 35 U.S.C. §101 as being drawn to non-patentable subject matter. This rejection is traversed and reconsideration is respectfully requested.

On page 4 of the Office Action, the Examiner summarily states that the claims are "mere arrangements of data, and thus are not statutory." While the Examiner asserts that the arguments of the Amendment filed December 19, 2005 are not persuasive, the Examiner does not provide any analysis as to the reasons therefore and instead summarily states that the "data elements claimed have no stored relationship." However, this assertion is merely a restatement of the test for statutory subject matter, does further not indicate how the data as recited is non-statutory, does not apply the various factors outlined in MPEP 2100-12 to the recited features, and does not address applicant's request for such analysis as required to substantiate a prima facie rejection under 35 U.S.C. §101 as set forth in the Amendment filed December 19, 2005.

By way of review and example, claim 5 recites, among other features, "a rights management information area to indicate to the recording and/or reproducing apparatus whether said content data is the original content data or the copied content data transcribed from the original content data such that the recording and/or reproducing apparatus distinguishes between the original and copied content data, and to indicate to the recording and/or reproducing apparatus rights information related to the recording and/or reproducing apparatus performing data transcribing of said content data."

As previously noted in the Amendment filed December 19, 2005, even assuming *arguendo* that stored data file information and the rights management information area, *per se*, are non-functional descriptive material, it is noted that claim 5 recites more than a mere storage of data. Instead, claim 5 also recites a functional relationship between the elements, such as the elements logically connected using the rights management information area and the result of the relationship by a recording and/or reproducing apparatus reading the information from the rights management information area. Thus, the stored data file information and the rights management information area have a specific logical relationship which supports specific data manipulation functions.

Since claim 34 also recites a logical relationship between the identification information and rights information to be implemented by a computer, claims 5 and 34 recite data structures which support specific data manipulation functions so as to be distinguishable from mere listings of data. As such, claims 5 and 34 are considered functional descriptive material. As such, it is respectfully submitted that the Examiner has not presented sufficient evidence to support a *prima facie* rejection of the claims for the purposes of 35 U.S.C. §101.

Lastly, the Examiner has not addressed these arguments as previously presented in the Amendment of December 19, 2005 and has again not indicated how at least these relationships recited in claims 5 and 34 are not sufficient to render claims 5 and 34 statutory subject matter. Thus, it is respectfully submitted that the Examiner has not rebutted or addressed applicant's argument or otherwise provided clarifying detail for the continued rejection which either clarifies the Examiner's position or otherwise advances prosecution.

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal. Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the applicant's traversals can be deemed an admission that

the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999). As such, since the Examiner has not addressed the applicant's traversals presented in the Amendment of December 19, 2005, it is respectfully submitted that the failure represents an admission as to the statutory nature of claims 5, 6, and 34-42. Therefore, it is requested that the Examiner withdraw the rejection of these claims under 35 U.S.C. §101.

**STATUS OF CLAIMS NOT REJECTED:**

On page 1 of the Office Action, the Examiner allows claims 1-4, 7, 9-33, and 43-46.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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